

Applicants have specifically addressed each and every one of the Examiner's comments to the Claims in the Amendments hereto. Thus, Applicants respectfully submit the remaining claims, as amended herewith, are allowable and an early notification of allowance is requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Since this amendment is being filed within the fourth month statutory period from the date of the Office Action, a one-month extension of time and the fees therefor are filed herewith.

Please charge any additional fees or credit any overpayment to our Deposit Account No. 19-1995. A duplicate copy of this letter is enclosed for that purpose.

#### **I. Double Patenting**

The Office Action rejected Claims 1-8 of the Application under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 8 of U.S. Pat. No. 6,198,479 to Humpleman et al. Because the reference and the instant Application are commonly owned, Applicants have herewith filed a terminal disclaimer in compliance with 37 CFR 1.321(c) to obviate the double patenting rejection over the prior art. Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 1-8 thereunder because the rejections are hereby rendered moot. However, if the terminal disclaimer fails to overcome the rejection, Applicants reserve the right to file a substantive response.

## II. Claim Rejections – 35 USC §103(a)

The Office Action rejected **Claims 1-4, 6 and 8** under §103(a) as being unpatentable over U.S. Pat. No. 5,956,487 to Venkatraman et al. (hereinafter “Venkatraman”) in view of U.S. Pat. No. 6,148,346 to Hanson. Applicants respectfully traverse the rejection of the claims, and the modification and combination of the references in applying the Section 103 rejection.

As to **Claim 1**, Applicants respectfully traverse the Office Action’s assertion that Venkatraman or Hanson, either alone or in combination, teaches the limitations of Applicants’ claimed device or renders the same obvious.

First, it is well settled that the reference itself must suggest the modification or combination proposed in order for the modification or combination to be valid; “[the] invention cannot be found obvious unless there was some **explicit** teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). “The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound.” *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). There is no suggestion from either reference that they be combined or modified as proposed by the Office Action and, in fact, even the Office Action

fails to provide the necessary impetus for the modification. In addition, as illustrated through more detailed examples below, the references teach away from Applicant's claimed invention and do not provide any suggestion for their combination or modification.

Second, neither Venkatraman nor Hanson teaches or renders obvious all of the limitations of Applicants' claimed invention. Venkatraman does not provide a means that may automatically locate and access the devices. In fact, Venkatraman teaches away from Applicants' claimed invention by requiring that,

A user of one of the computer systems 90-92 enters a URL corresponding to the desired one of the devices 10 and 50-52 into the corresponding web browser application. In response, the particular web browser application as an HTTP client transfers an HTTP command that specifies the desired URL over the large organization network 80. The device specified by the HTTP command recognizes the URL contained therein. In response, the targeted device transfers an HTML file that defines its device web page via large organization network 80.

Venkatraman, Column 7, lines 36-46.

Conversely, Applicants' claimed invention provides a session manager that determines the location and availability of the devices connected to the network in a dynamic fashion. Accordingly,

even if the combination were legally justified, it would not teach all the limitations of Applicants' claimed invention because the method of receiving a URL from a home device is admittedly not taught by Venkatraman.

Furthermore, Hanson also fails to provide a session manager that determines the location and availability of the devices connected to the network in an autonomous manner and requires specific entry of the location thereof by the administrator, "[t]he network administrator is prompted to insert URL codes that access the help files that are in HTML format."

Third, Applicants respectfully submit that the Office Action is improperly using "hindsight" and the teachings of Applicants' own claimed invention in order to improperly combine the references in an attempt to render Applicants' claims obvious. The Office Action admits that Venkatraman fails to teach all of the limitations of Applicant's claimed invention. However, the Office Action improperly attempts to modify and combine Hanson, which also fails to teach all of the limitations of Applicants' claimed invention, with Venkatraman in an attempt to achieve Applicants' claimed invention.

The Office Action admits that Venkatraman “does not specifically teach a device link file associated with connected home devices.” However, the Office Action improperly states that Hanson, Figure 5, column 5, lines 36-40, teaches autonomously generating a device link file to determine the connected home devices. To the contrary, as set forth in greater detail above, Hanson requires that the network administrator determine the location of the device and enter the information.

Fourth, the Office Action recognizes the advantages of the presently claimed invention by trying to make modifications in Venkatraman and Hanson to provide an autonomous determination of the devices that are connected to the network and the associated control functions thereof. Applicants respectfully submit that the fact that the modification produces advantages in allowing the determination of the available devices without entry of the location thereof by the network administrator militates in favor of the patentability of Applicants’ claimed invention because it proves that the combination produces new and advantageous results and hence is unobvious.

Finally, if Applicants’ claimed invention were in fact obvious, those skilled in the art would

have modified the teachings of Venkatraman to incorporate the teachings of Hanson. The fact that neither Venkatraman nor Hanson has been modified, since their teachings have been known for numerous years, to implement Applicants' claimed invention, despite its great advantages, indicates that Applicants' claimed invention is neither obvious nor taught by the prior art.

Therefore, Applicants respectfully request withdrawal of the rejection of Claim 1 because the combination and modification of the references is improper and does not disclose all the limitations of Applicants' claimed invention.

As to **Claims 2-4**, the Office Action asserts that Venkatraman shows the methods of Applicants' claimed invention. Applicants respectfully traverse this proposition and assert that since Claim 2 incorporates the novel and unobvious limitations of Claim 1, it is therefore allowable for its dependency due to the reasons set forth above in relation to the rejection of Claim 1, as well as for its own novel sub-features.

First, it is well settled that "A plurality of claims should never be grouped together in a common rejection..." and that an omnibus rejection of the claims is inappropriate because it does

not delineate the reasoning for the rejections and does not allow the Applicant to form a lucid response. MPEP 707.07(d). If Claims 2-4 are once again rejected, Applicants respectfully request a reasoning for each rejection such that Applicant may form a lucid and informed response thereto. Nevertheless, Applicants respectfully traverse the rejection and assert the patentability of Claims 2-4 hereinafter.

Second, as set forth in greater detail above, it is well settled that the reference itself must suggest the modification or combination proposed in order for the modification or combination to be valid. There is no suggestion or motivation from either reference that they be combined or modified as proposed by the Office Action and, in fact, even the Office Action fails to provide the necessary impetus for the modification. In addition, as illustrated through more detailed examples below, the references teach away from Applicant's claimed invention and do not provide any suggestion for their combination or modification.

Third, neither Venkatraman nor Hanson teaches or renders obvious all of the limitations of Applicants' claimed invention, either alone or in combination. Venkatraman does not provide a

means that may automatically locate and access the devices. In fact, Venkatraman teaches away from Applicants' claimed invention by requiring that,

A user of one of the computer systems 90-92 enters a URL corresponding to the desired one of the devices 10 and 50-52 into the corresponding web browser application. In response, the particular web browser application as an HTTP client transfers an HTTP command that specifies the desired URL over the large organization network 80. The device specified by the HTTP command recognizes the URL contained therein. In response, the targeted device transfers an HTML file that defines its device web page via large organization network 80.

Venkatraman, Column 7, lines 36-46.

Conversely, Applicants' claimed invention provides a session manager that determines the location and availability of the devices connected to the network in a dynamic fashion. Accordingly, even if the combination were legally justified, it would not teach all the limitations of Applicants' claimed invention because the method of receiving a URL from a home device is admittedly not taught by Venkatraman.

Furthermore, Hanson also fails to provide a session manager that determines the location and availability of the devices connected to the network in an autonomous manner and requires specific entry of the location thereof by the administrator, "[t]he network administrator is prompted to insert URL codes that access the help files that are in HTML format."



Fourth, Applicants respectfully submit that the Office Action is improperly using “hindsight” and the teachings of Applicants’ own claimed invention in order to improperly combine the references in an attempt to render Applicants’ claims obvious. The Office Action admits that Venkatraman fails to teach Applicants’ retrieval and association of the device from the device link file as well as the icons therefor. However, the Office Action improperly attempts to modify and combine Hanson, which also fails to teach all of the limitations of Applicants’ claimed invention, with Venkatraman in an attempt to achieve Applicants’ claimed invention. The Office Action states that Hanson teaches a listing of available devices; however, the process of listing the devices is the novel and unobvious limitation claimed by Applicants which is neither contemplated nor rendered obvious by Applicants.

Fifth, the Office Action recognizes the advantages of the presently claimed invention by trying to make modifications in Venkatraman and Hanson to provide an autonomous determination of the devices that are connected to the network and the associated control functions thereof. Applicants respectfully submit that the fact that the modification produces advantages in allowing the determination of the available devices without entry of the location thereof by the network

administrator militates in favor of the patentability of Applicants' claimed invention because it proves that the combination produces new and advantageous results and hence is unobvious.

Finally, if Applicants' claimed invention were in fact obvious, those skilled in the art would have modified the teachings of Venkatraman to incorporate the teachings of Hanson. The fact that neither Venkatraman nor Hanson has been modified, since their teachings have been known for numerous years, to implement Applicants' claimed invention, despite its great advantages, indicates that Applicants' claimed invention is neither obvious nor taught by the prior art.

Therefore, Applicants respectfully request withdrawal of the rejection of Claim 2-4 because the combination and modification of the references is improper and does not disclose all the limitations of Applicants' claimed invention and because the rejection thereof does not comply with the requirements set forth in the MPEP.

The Office Action rejected **Claim 6** under §103(a) as being unpatentable over Venkatraman. Applicants incorporate herein the remarks above set forth as to the novelty and unobviousness of Claim 1. In addition, the Office Action acknowledges that Venkatraman fails to teach all of the

limitations of Applicants' invention and the rejection of Claim 6 under section 103 is therefore improper.

First, in the "Response to Arguments" section of the Office Action, it is claimed that the arguments are moot in view of the new ground(s) of rejection. Section 707.07 et. seq. of the Manual of Patent Examining Procedure clearly indicates that such a general refusal of Applicant's arguments is clearly inappropriate, "The examiner must, however, address any arguments presented by the Applicants which are still relevant to any references being applied." (emphasis added) The Venkatraman reference is reapplied by the Office without addressing the Applicants' arguments which clearly overcome the rejections. Accordingly, Applicants respectfully request that Applicants arguments be specifically addressed such that Applicant may form a lucid response thereto or the claim allowed. In addition, because of the inappropriate rejection of the claim, Applicants respectfully assert that if the Office is not going to allow the claims in light of the amendments and arguments herein, that a final rejection would clearly be inappropriate. Accordingly, Applicants respectfully request a further non-final Office Action which addresses Applicants' arguments.

Second, it is well settled that for a modification or combination of the prior art to be proper, the prior art itself must provide a suggestion therefor. Venkatraman fails to suggest any combination or modification thereof and in fact the Office Action fails to modify the same or provide a suggestion or motivation therefo.

Third, Venkatraman does not show all of the limitations of Applicants' claimed invention. In fact, Venkatraman teaches away from Applicants' claimed invention by requiring that "A user of one of the computer systems 90-92 enters a URL corresponding to the desired one of the devices 10 and 50-52 into the corresponding web browser application." (Venkatraman, Column 7, lines 36-38)

Conversely, Applicants' claimed invention provides a session manager that determines the location and availability of the devices connected to the network in a dynamic fashion. Accordingly, even if the combination were legally justified, it would not teach all the limitations of Applicants' claimed invention because the method of receiving a URL from a home device is admittedly not taught by Venkatraman.

Finally, the Office Action seems to recognize the advantages of the presently claimed invention by trying to make modifications in Venkatraman to achieve the claimed invention. The

previous Office Action admits that Applicants' method of providing of a URL associated with the device provides increased information selectivity. However, the Office Action then attempts to improperly modify Venkatraman to achieve the advantages of Applicants' claimed invention.

Applicants respectfully submit that the fact the modification produces admitted advantages militates in favor of the patentability of Applicants' claimed invention because it proves that the combination produces new and unexpected results and hence is unobvious.

Therefore, Applicants respectfully request withdrawal of the rejection of Claim 6 because the modification of the reference is improper and the Office Action fails to comply with the requirements of the MPEP.

The Office Action rejected **Claims 5 and 7** under §103(a) as being unpatentable over Venkatraman and Hanson as applied to Claim 1, and further in view of Reber et al. (hereinafter Reber). Applicants also respectfully traverse the rejection and the modification and combination of Venkatraman, Hanson and Reber.

First, it is well settled that "A plurality of claims should never be grouped together in a common rejection..." and that an omnibus rejection of the claims is inappropriate because it does

not delineate the reasoning for the rejections and does not allow the Applicant to form a lucid response. MPEP 707.07(d). If Claims 2-4 are once again rejected, Applicants respectfully request a reasoning for each rejection such that Applicant may form a lucid and informed response thereto. Nevertheless, Applicants respectfully traverse the rejection and assert the patentability of Claims 2-4 hereinafter.

Second, in the "Response to Arguments" section of the Office Action, it is claimed that the arguments are moot in view of the new ground(s) of rejection. Section 707.07 et. seq. of the Manual of Patent Examining Procedure clearly indicates that such a general refusal of Applicant's arguments is clearly inappropriate, "The examiner must, however, address any arguments presented by the Applicants which are still relevant to any references being applied." (emphasis added) The Venkatraman reference is reapplied by the Office without addressing the Applicants' arguments which clearly overcome the rejections. Accordingly, Applicants respectfully request that Applicants arguments be specifically addressed such that Applicant may form a lucid response thereto or the claim allowed. In addition, because of the inappropriate rejection of the claim, Applicants respectfully assert that if the Office is not going to allow the claims in light of the amendments and

arguments herein, that a final rejection would clearly be inappropriate. Accordingly, Applicants respectfully request a further non-final Office Action which addresses Applicants' arguments.

Third, Applicants incorporate herein the remarks set forth above in response to the rejection of Claim 1 that clearly illustrates the novel and unobvious aspects of the claim over the references cited. As a result of the dependence of Claims 5 and 7 from Claim 1, Applicants respectfully assert that Claims 5 and 7 are in turn allowable.

Fourth, it is well settled that for a modification or combination of the prior art to be proper, the prior art itself must provide a suggestion for the asserted modification. Applicants respectfully traverse the proposed combination and modification. Reber teaches advertising on a first web page by displaying a logo of a sponsor that is linked to the web page of the sponsor. Accordingly, because the user is already on the first web page, there would be no reason or motivation for Reber to provide a logo of the first web page that links to itself. In addition, because Venkatraman already accesses the web page of the device to download information therefrom, there would be no reason to provide a logo to do so. Furthermore, because Hanson teaches providing a control mechanism for a printer accessed through a URL, there would be nor reason to provide a logo for an alternate

printer. Therefore, because of the diverse functioning of the references, there would be no motivation for the combination thereof to provide a LOGO as claimed by Applicants.

Finally, the Office Action seems to recognize the advantages of the presently claimed invention by trying to make “hind-sight” modifications to the references to achieve the claimed invention. The Office Action acknowledges that Applicants’ LOGO provides increased device recognition and attempts to improperly combine divergent references to achieve the advantages of Applicants’ claimed invention. Applicants respectfully submit that the fact the modification produces advantages in increasing device recognition by using a LOGO militates in favor of the patentability of Applicants’ claimed invention because it proves that the combination produces new and unexpected results and hence is unobvious.

Therefore, Applicants respectfully request withdrawal of the rejection of Claims 5 and 7 because the combination and modification of the references is improper and does not disclose all of the claimed limitations thereof.



### **III. References Cited and Not Relied Upon**

Applicants have reviewed the references cited and not relied upon and respectfully assert that the references neither teach nor render obvious Applicants' claimed invention.

### **IV. Response to Arguments**

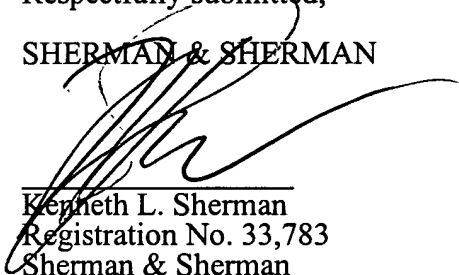
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## CONCLUSION

It is respectfully submitted that the case is now in condition for allowance, and an early notification of the same is requested. If it is believed that a telephone interview will help further the prosecution of this case, Applicants respectfully request that the undersigned attorney be contacted at the listed telephone number.

Respectfully submitted,

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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service first class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on 5/8/02.

Evelyn Menjivar

(Type or print name of person mailing paper)



(Signature of person mailing paper)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. A method for providing an interface for accessing home devices that are currently connected to a home network, the method comprising the steps of:

generating a device link file, wherein the device link file identifies home devices that are currently connected to the home network in an autonomous manner;

creating a device link page [from at least the local network], wherein the device link page contains at least one graphical or textual representation of corresponding devices that are [a device button that is associated with each home device that is] identified in the device link file;

associating a hyper-text link with each device[ button] representation, wherein the hyper-text link provides a link to [an HTML] a web page that is contained [on the home] in the device that is associated with the device [button] representation; and

displaying the device link page on a browser based [home] device.